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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/620,904

07/16/2003

Joseph L. Tallal JR.

GM2:1003RCE

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12/18/2008

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EXAMINER

RAPILLO, KRISTINE K

ART UNIT

PAPER NUMBER

3626

MAIL DATE

DELIVERY MODE

12/18/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/620,904	Applicant(s) TALLAL, JOSEPH L.	
	Examiner KRISTINE K. RAPILLO	Art Unit 3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9, 12-16 and 25-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 12-16 and 25-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 10/29/2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/23/2005</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. This communication is in response to the Request for Continued Examination (RCE) filed October 29, 2008. Claims 17 - 20 are cancelled. Claims 25 - 28 are amended. Claims 2 – 9, 12 – 16, and 21 - 28 are presented for examination.

Request for Continued Examination

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on October 29, 2008 has been entered.

Drawings

3. The objection to the drawings is hereby withdrawn based upon the amendment submitted October 29, 2008.

Claim Objections

4. The objection to claim 25 is withdrawn based upon the amendment submitted October 29, 2008.

Double Patenting

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct

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from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 2 – 7, 12 – 16, 21 – 23, and 26 - 28 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 2 – 7 and 10 - 21 of copending Application No. 10/620,903 (Tallal). This is a provisional obviousness-type double patenting rejection. Although the conflicting claims are not identical, they are not patentably distinct from each other because all the limitations from the claims of U.S. Application No. 10/620,904 are covered in the claims of U.S. Application No. 10/620,903.

7. The table below is a comparison of all obvious-type double patenting claims. The differences between the claims have been bolded and a summary of the rejection is included in the row directly below the affected claims.

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2. The <u>method</u> as recited in claim <u>26</u> , wherein the discount price list is a variable discount price list that tracks a known standard service/good price list.	2. The method as recited in claim 20, wherein the discount price list is a variable discount price list that tracks a known standard pharmaceutical price list.

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Regarding claim 2, the standard service price list and the standard pharmaceutical price list serve the same function in that they both track a standard price list, therefore, claim 2 of this application is not patentably distinct from claim 2 of the reference application.	
3. The <u>method</u> as recited in claim <u>26</u> , wherein the membership fee to is paid by the individual.	3. The method as recited in claim 20, wherein the membership fee is paid by the individual
Regarding claim 3, a network provider is providing the same function as a pharmacy benefit manager. Each function assumes the responsibility to oversee a health care plan, in which the network provider and pharmacy benefit manager are the recipients of the membership fees used join the health care plan or pharmaceutical benefit program. Therefore, claim 3 of this application is not patentably distinct from claim 3 of the reference application.	
4. The <u>method</u> as recited in claim <u>26</u> , wherein the membership fee is paid by the individual's employer.	4. The method as recited in claim 20, wherein the membership fee is paid by the individual's employer.
Regarding claim 4: Claim 4 is not patentably distinct from claim 4 of the reference application, therefore, claim 4 is obvious.	
5. The <u>method</u> as recited in claim <u>26</u> , wherein the membership fee is paid by the individual's business.	5. The method as recited in claim 20, wherein the membership fee is paid by the individual's business.
Regarding claim 5: Claim 5 is not patentably distinct from claim 5 of the reference application, therefore, claim 5 is obvious.	
6. The <u>method</u> as recited in claim <u>26</u> , wherein the membership fee is a renewal fee.	6. The method as recited in claim 20, wherein the membership fee is a renewal fee.
Regarding claim 6: Claim 6 is not patentably distinct from claim 6 of the reference application, therefore, claim 6 is obvious.	
7. The <u>method</u> as recited in claim <u>26</u> , wherein the member includes his/her family in the health care plan .	7. The method as recited in claim 20, wherein the member includes his/her family in the pharmaceutical benefit program .
Regarding claim 7, a pharmaceutical benefit program is an off-shoot of a health care plan – a health care plan provides for medical services, whereas a pharmaceutical benefit program provides for prescription drug medication (which is generated from a medical service visit). Therefore, claim 7 is obvious.	
12. The <u>method</u> as recited in claim <u>26</u> , wherein the basic listings are provided to medical service/good providers free of charge.	10. The method as recited in claim 20, wherein the basic listings are provided to pharmaceutical companies free of charge.

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Regarding claim 12: Claim 12 is not patentably distinct from claim 10 of the reference application, therefore, claim 12 is obvious.		
13. The <u>method</u> as recited in claim <u>26</u> , wherein the premium listings are provided to medical service/good providers upon payment of a premium listing fee.		11. The method as recited in claim 20, wherein the premium listings are provided to pharmaceutical companies upon payment of a premium listing fee.
Regarding claim 13: Claim 13 is not patentably distinct from claim 11 of the reference application, therefore, claim 13 is obvious.		
14. The <u>method</u> as recited in claim <u>26</u> , wherein the premium listings include a link to a customizable web page for the medical service/good providers that is accessible via a global telecommunications network.		12. The method as recited in claim 20, wherein the premium listings include a link to a customizable web page for the pharmaceutical company that is accessible via a global telecommunications network.
Regarding claim 14: Claim 14 is not patentably distinct from claim 12 of the reference application. Claim 14 of the application refers to a web page for a medical service/good provider whereas claim 12 of the reference refers to a web page for a pharmaceutical company. The same system can be used for the pharmaceutical company and medical service/good provider therefore claim 14 is obvious.		
15. The <u>method</u> as recited in claim <u>26</u> , wherein the premium listings include a link to the medical service/good provider's web site.		13. The method as recited in claim 20, wherein the premium listings include a link to the pharmaceutical company's web site.
Regarding claim 15: Claim 15 is not patentably distinct from claim 13 of the reference application therefore claim 15 is obvious.		
16. The <u>method</u> as recited in claim <u>26</u> , wherein the premium listings are customized for each medical service/good provider .		14. The method as recited in claim 20, wherein the premium listings are customized for each pharmaceutical company .
Regarding claim 16: Claim 16 is not patentably distinct from claim 14 of the reference application therefore claim 16 is obvious.		
21. The <u>method</u> as recited in claim <u>26</u> , further comprising one or more advertisements provided by the network provider to the members.		17. The method as recited in claim 20, further comprising one or more advertisements provided by the pharmacy benefit manager to the members.

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Regarding claim 21, a network provider is providing the same function as a pharmacy benefit manager, as per claim 26. Therefore, claim 21 of this application is not patentably distinct from claim 17 of the reference application.	
22. The <u>method</u> as recited in claim 21, wherein an advertiser pays the network provider an advertising fee to provide the advertisements to the members.	18. The method as recited in claim 17, wherein an advertiser pays the pharmacy benefit manager an advertising fee to provide the advertisements to the members.
Regarding claim 22, a network provider is providing the same function as a pharmacy benefit manager, as per claim 26. Therefore, claim 18 of this application is not patentably distinct from claim 22 of the reference application.	
23. The <u>method</u> as recited in claim 21, wherein the advertisement provided to a member is based on one or more search criteria used to search the medical service/good provider listing.	19. The method as recited in claim 18, wherein the advertisement provided to a member is based on one or more search criteria used to search the pharmaceutical listing.
Regarding claim 23: Claim 23 is not patentably distinct from claim 19 of the reference application therefore claim 23 is obvious.	
<p>26. A method for providing a health care plan comprising the steps of:</p> <p>receiving a membership fee from one or more individuals to become members of the health care plan;</p> <p>obtaining information from one or more medical service/good providers that have joined the health care plan;</p> <p>providing a medical service/good provider listing for the medical service/good providers based on the obtained information, wherein the medical service/good provider listing is accessible by the members via a global telecommunications network, comprises basic listings and premium listings for the medical service/good providers, and is searchable by the members using one or more</p>	<p>20. A method for providing a pharmaceutical benefit program comprising the steps of:</p> <p>receiving a membership fee from one or more individuals to become members of the pharmaceutical benefit program;</p> <p>obtaining information from one or more pharmaceutical companies that have joined the pharmaceutical benefit program;</p> <p>providing a pharmaceutical listing for the pharmaceuticals based on the obtained information, wherein the pharmaceutical listing is accessible by the members via a global telecommunications network, comprises basic listings and premium listings for the pharmaceutical companies, and is searchable by the members using one or more search criteria comprising a geographic area or a</p>

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<p>search criteria comprising a geographic area or a service/good provided by the medical service/good providers; and</p> <p>providing a discount price list to the members via the global telecommunications network, wherein the discount price list comprises published rates for the services/goods provided by the medical service/good providers for two or more geographic areas and each member can only access the published rates for the geographic area associated with the member, and the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list.</p>	<p>pharmaceutical provided by the pharmaceutical companies; and</p> <p>providing a discount price list listing to the members via the global telecommunications network, wherein the discount price list comprises published rates for the pharmaceuticals provided by the pharmaceutical companies for two or more geographic areas and each member can only access the published rates for the geographic area associated with the member, and the discount price list regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list.</p>
<p>Regarding claim 26:</p> <ul style="list-style-type: none"> • A network provider is providing the same function as a pharmacy benefit manager. • The term pharmaceuticals is encompassed by the generic term of services/goods. <p>Therefore, claim 26 of this application is not patentably distinct from claim 20 of the reference application.</p>	
<p>27. A computer program embodied on a computer readable medium executable by a server for providing a health care plan comprising:</p> <p>a code segment for receiving a membership fee from one or more individuals to become members of the health care plan;</p> <p>a code segment for obtaining information from one or more medical service/good providers that have joined the health care plan; and</p> <p>a code segment for providing a medical service/good providers listing for the medical service/good providers based on the obtained information, wherein the medical service/good providers listing is accessible by the members via a global telecommunications network, comprises basic listings and premium listings for the medical service/good providers and is searchable by the members using one or more search criteria comprising a geographic area or</p>	<p>21. A computer program embodied on a computer readable medium executable by a server for providing a pharmaceutical benefit program comprising:</p> <p>a code segment for receiving a membership fee from one or more individuals to become members of the pharmaceutical benefit program; and</p> <p>a code segment for obtaining information from one or more pharmaceutical companies that have joined the pharmaceutical benefit program;</p> <p>a code segment for providing a pharmaceutical listing for the pharmaceuticals based on the obtained information, wherein the pharmaceutical listing is accessible by the members via a global telecommunications network, comprises basic listings and premium listings for the pharmaceutical companies, and is searchable by the members using one or more search criteria comprising a geographic area or a pharmaceutical provided by the pharmaceutical companies; and</p>

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<p>a service/good provided by the medical service/good providers; and</p> <p>a code segment for providing a discount price list to the members via the global telecommunications network, wherein the discount price list comprises published rates for the services/goods provided by the medical service/good providers for two or more geographic areas and each member can only access the published rates for the geographic area associated with the member, and the discount price list ~ regulates the cost of services/goods provided to the members by the medical service/good providers such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list.</p>	<p>a code segment for providing a discount price list to the members via the global telecommunications network, wherein the discount price list comprises published rates for the pharmaceuticals provided by the pharmaceutical companies for two or more geographic areas and each member can only access the published rates for the geographic area associated with the member, and the discount price list regulates the cost of pharmaceuticals provided to the members by a pharmaceutical benefit program such that the members pay the pharmaceutical benefit program in-full directly for any pharmaceuticals provided to the members based on the discount price list.</p>
<p>Regarding claim 27:</p> <ul style="list-style-type: none"> • A network provider is providing the same function as a pharmacy benefit manager. • The term pharmaceuticals is encompassed by the generic term of services/goods. <p>Therefore, claim 27 of this application is not patentably distinct from claim 21 of application 10/620,903.</p>	
<p>28. An apparatus for providing a health care plan comprising:</p> <p>a server;</p> <p>one or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price listing to the members via a global telecommunications network, wherein the discount price list comprises published rates for the services/goods provided by the medical service/good providers for two or more geographic areas and each member can only access the published rates for the geographic area associated with the member, and the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list,</p> <p>a communications interface communicably</p>	<p>22. An apparatus for providing a pharmaceutical benefit program comprising:</p> <p>a server;</p> <p>one or more storage devices communicably coupled to the server, the one or more data storage devices containing a discount price list to the members via a global telecommunications network, wherein the discount price list comprises published rates for the pharmaceuticals provided by the pharmaceutical companies for two or more geographic areas and each member can only access the published rates for the geographic area associated with the member, and the discount price list regulates the cost of pharmaceuticals provided to the members by a pharmacy benefit manager such that the members pay the pharmacy benefit manager in-full directly for any pharmaceuticals provided to the members based on the discount price list,</p> <p>a communications interface communicably coupled</p>

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coupled to the server that allows the members to access the discount price list and the medical service/good provider listing, wherein the medical service/good provider listing comprises basic listings and premium listings for the medical service/Good providers, and is searchable by the members using one or more search criteria comprising the geographic area or a service/good provided by the medical service/good providers; and wherein the member is an individual that has paid a membership fee to join the health care plan.	to the server that allows a member to access the discount price list and a pharmaceutical listing, wherein the pharmaceutical listing comprises basic listings and premium listings for the pharmaceutical companies, and is searchable by the members using one or more search criteria comprising a geographic area or a pharmaceutical provided by the pharmaceutical companies; and wherein the member is an individual that has paid a membership fee to join the pharmaceutical benefit program.
<p>Regarding claim 28:</p> <ul style="list-style-type: none"> • A network provider is providing the same function as a pharmacy benefit manager. • The term pharmaceuticals is encompassed by the generic term of services/good. <p>Therefore, claim 28 of this application is not patentably distinct from claim 22 of application 10/620,903.</p>	

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 2 –9, 12 – 16 and 21 – 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Care Entrée (<http://web.archive.org/web/20011130030647/http://carentree.com>, 2001) in view of Ferguson et al., hereinafter Ferguson (U.S. Patent Number 5,819,092), in view of Lipton, et al., hereinafter Lipton (“Pharmacy benefit management companies: Dimensions of performance”, Annual Review of Public Health. Palo Alto: 1999. Vol. 20, page 361) further in view of Goch (“A New Card Deal.” Best’s Review. Oldwick: Jul 2002 (vol. 103, Iss. 3; page 73).

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In regard to Claim 26 (currently amended): Care Entree teaches a method for providing a health care plan comprising the steps of: receiving a membership fee from one or more individuals to become members of the health care plan (Care Entrée: paragraphs 10 and 12) and obtaining information from one or more medical service/good providers that have joined the health care plan (Care Entrée: paragraph 41)

Care Entrée fails to teach a method comprising the steps of: providing a medical service/good provider listing for the medical service/good providers based on the obtained information, wherein the medical service/good provider listing is accessible by the members via a global telecommunications network, comprises basic listings and premium listings for the medical service/good providers and is searchable by the members using one or more search criteria comprising a geographic area or a service/good provided by the medical service/good providers; and providing a discount price list to the members via the global telecommunications network, wherein the discount price list comprises published rates for the services/goods provided by the medical service/good providers for two or more geographic areas and each member can only access the published rates for the geographic area associated with the member, and the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list.

Ferguson teaches a method comprising the steps of:

providing a medical service/good provider listing for the medical service/good providers based on the obtained information (Ferguson: column 14, lines 2 – 6), wherein the medical service/good provider listing is accessible by the members via a global telecommunications network (Ferguson: column 7, lines 37 – 42 and column 14, lines 2 – 6; the Examiner interprets the lookup subservice directory disclosed by Ferguson to be an electronic directory where the person can be equated to a medical provider and a company equated to a hospital), is searchable by the members using one or more search criteria comprising a geographic area or a service/good provided by the medical service/good providers (Ferguson: column 10, lines 25 – 65) where the search criteria can be based on a geographical location as the fields may be chosen by the author/user of the program; and

providing a discount price list to the members via the global telecommunications network (Ferguson: column 7, lines 37 – 42 and column 14, lines 2 – 6 where Ferguson describes online service), wherein the discount price list comprises published rates for the services/goods provided by the medical service/good providers for two or more geographic areas (Ferguson: column 14, lines 2 – 31) where Ferguson discloses a list which can include a person or company as well as disclosing an example online service which may include a catalog of products (which equates to published rates for services/goods) available electronically (column 19, lines 26 - 41); and where each member can only access the published rates for the geographic area associated with the member (Ferguson: column 3, lines 41 - 55).

Ferguson fails to teach a method comprising the steps of providing a medical service/good provider listing comprises basic listings and premium listings for the medical service/good providers and the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list.

Lipton teaches a method comprising the steps of providing a medical service/good provider listing comprises basic listings and premium listings for the medical service/good providers (Lipton: paragraphs 7, 41 - 45, and 111) and the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider such that the members pay the medical service/good providers (Lipton: paragraph 30) in-full directly for any services/goods rendered to the members based on the discount price list. Lipton fails to teach the payment in full directly for any services/goods rendered to the members based on the discount price list.

Goch teaches a method where the payment in full directly for any services/goods rendered to the members based on the discount price list (Goch: paragraph 20). Goch's article discussed the Care Entrée program and supports the Care Entrée reference used.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method such that the members pay the medical service/good providers in full directly for any services/goods rendered to the members based on the discount price list as taught

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by Goch, within the method of Care Entrée, Ferguson, and Lipton, with the motivation of ensuring a discounted cost for medical services (paragraph 18).

As per claim 2 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as per claim 26. Lipton further teaches a method in which the discount price list is a variable discount price list that tracks a known standard service/good price list (paragraph 7). This is accomplished through the use of negotiated discounts with pharmacy networks, as well as controlling the formularies used by the pharmacy benefit manager (i.e. the pharmacy benefit manager chooses which drugs to include in the formulary, thereby lowering the cost of the pharmaceuticals). This same method can be applied to a list of services provided by a medical provider, wherein negotiated discounts are applied to medical providers, hospitals, hearing, vision, etc. It can be assumed that lists are required to provide network provider with the recent price list, as well as the discounted price list.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method in which the discount price list is a variable discount price list that tracks a known standard service/good price list as taught by Lipton, within the method of Care Entrée, Ferguson and Goch, with the motivation of managing medical costs and services (paragraphs 32 through 34).

As per claim 3 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. Care Entrée further teaches a method wherein the membership fee is paid by the individual (paragraph 10). The Care Entrée program discloses a method in which anyone can pay a certain fee to join a health care plan.

As per claim 4 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. The Care Entrée program further teaches a method in which the membership fee is paid by the individual's employer (paragraph 67).

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As per claim 5 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. The Care Entrée program further teaches a method in which the membership fee is paid by the individual's business (paragraph 67). The examiner interprets an individual's employer, in this case, to be equivalent to an individual's business. In either case, the individual is provided the opportunity to offer employees (including self) a supplemental health care plan.

As per claim 6 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. The Care Entrée program further teaches a method wherein the membership fee is a renewal fee (paragraph 6). The examiner interprets the monthly fee to be a renewal fee – the member is paying a renewal fee every month.

As per claim 7 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. The Care Entrée program further teaches a method wherein the member can include his/her family in the health care plan (paragraph 10). The Care Entrée program allows the entire family (including all dependents recognized by the Internal Revenue Service) to join the health care plan.

As per claim 8 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. The Care Entrée program further teaches a method wherein the medical service/good providers are selected from the group consisting of physicians, hospitals, physical therapists, nursing facilities, cancer treatment centers, optical and hearing aid dispensaries, hospices, clinics, pharmacies, chiropractors, dentists, medical supply stores, hospital supply stores, and handicap equipment suppliers (paragraphs 61 – 63). Although physical therapy, cancer treatment centers, and medical, hospital, and handicap supply stores are not specifically taught in the Care Entrée program, these services/providers can be included as ancillary services, as taught by the Care Entrée program (paragraphs 21 – 23).

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As per claim 9 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. The Care Entrée program further teaches a method wherein the medical service/good provider is a doctor that works for a corporation (paragraph 16). The Care Entrée program refers to this as a PHCS (Private Health Care System).

As per claim 12 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. Ferguson further teaches a method wherein the basic listings are provided to medical service/good providers free of charge (column 13, lines 66 – 67 through column 14, lines 1 – 12). The examiner interprets the look up directory disclosed by Ferguson et al. to include a 'basic' listing – where a name, address and other related information is available.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method wherein the basic listings are provided to medical service/good providers free of charge as taught by Ferguson, within the method of Care Entrée, Ferguson, and Lipton, with the motivation of providing a tool to entice a physician or health care provider into purchasing premium listing using a system in which payments are required for premium listings (column 14, lines 13 - 31).

As per claim 13 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. Ferguson further teaches a method wherein the premium listings are provided to medical service/good providers upon payment of a premium listing fee (column 14, lines 6 – 12 and column 18, lines 33 - 35). The examiner interprets the look up directory disclosed by Ferguson et al. to include a 'premium' listing – where a name, address and a hyperlinked document with other related information is available.

The motivation for combining the teachings of the Care Entrée Program, Ferguson, Lipton, and Goch is discussed in claim 12.

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As per claims 14, 15, and 16 (all previously presented) Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. Ferguson further teaches a method wherein the premium listings include a link to a customizable web page for the medical services/goods provider accessible via a global telecommunications network, wherein the premium listings include a link to the medical service/good provider's web site, and wherein the premium listings are customized for each medical service/good provider (column 14, lines 6 – 19 and column 7, lines 37 - 42). The hyperlinks allow the user to access a site in which qualified users may submit new entries, thereby making it customizable.

Therefore it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of premium listings hyperlinked to a medical service/good providers web page (where the medical service/good provider can be equated to a pharmaceutical company) and is accessible to the global internet as taught by Ferguson with the motivation of allowing a user to create online services using existing information (column 7, lines 1 – 4).

As per claim 21 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. Ferguson further teaches a method comprising one or more advertisements provided by the network provider to the members (column 14, lines 6 – 12 and column 14, lines 21 – 31). Ferguson discloses a method of online classified advertisements, which are available using hyperlinked documents.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of placing online advertisements as taught by Ferguson with the motivation of increasing the sales of a medical services/goods provider by use of advertisements in the discount price list provided by the network provider (column 9, lines 54 – 56). An online service can be used as a tool to enable electronic commerce. In this case, the online service would advertise services of medical professionals, hospitals and more.

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As per claim 22 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. Ferguson further teaches a method wherein an advertiser pays the network provider an advertising fee to provide the advertisements to the members (column 18, lines 33 – 35).

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of charging a fee to place advertisements as taught by Ferguson with the motivation of creating an easy to use online service (column 10, lines 25 – 29) which can be used to generate revenue for a network provider by allowing a medical service/good provider to advertise on medical services/goods provider lists.

As per claim 23 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. Ferguson further teaches a method wherein the advertisement provided to a member is based on one or more search criteria used to search the medical service/good provider listing (column 14, lines 6 - 12). Searches can be made in directory look up's using names, categories or full text search techniques.

Therefore, it would have been obvious to a person of ordinary skill in the art at the time the invention was made to include a method of including advertisements when conducting a search of a medical service/good provider listing as taught by Ferguson with the motivation of introducing a revenue generating tool by charging a fee for the online service (column 14, lines 30 – 31).

As per claim 24 (previously presented), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 26. The Care Entrée program further teaches a method wherein the network provider is an insurance provider (paragraph 36). A PPO is defined as a preferred provider organization.

As per claim 25 (currently amended), Care Entrée, Ferguson, Lipton and Goch teach a method as recited in claim 24. The Care Entrée program further teaches a method wherein the insurance provider provides members with major medical insurance in return for payment of one or more major medical premiums (paragraph 5).

In regard to claim 27 (currently amended): Care Entrée teaches a computer program embodied on a computer readable medium executable by a server for providing a health care plan comprising: receiving a membership fee from one or more individuals to become members of the health care plan (Care Entrée: paragraph 10); obtaining information from one or more medical service/good providers that have joined the health care plan (Care Entrée: paragraph 41).

Care Entrée fails to teach a computer program embodied on a computer readable medium executable by a server for providing a health care plan comprising: a code segment; code segment for providing a medical service/good provider listing for the medical service/good providers based on the obtained information, wherein the medical service/good provider listing is accessible by the members via a global telecommunications network, comprises basic listings and premium listings for the medical service/good providers, and is searchable by the members using one or more search criteria comprising a geographic area or a service/good provided by the medical service/good providers; and a code segment for providing a discount price list to the members via the global telecommunications network, wherein the discount price list comprises published rates for the services/goods provided by the medical service/good providers for two or more geographic areas and the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list.

Ferguson teaches a computer program embodied on a computer readable medium executable by a server for providing a health care plan comprising: a code segment (Ferguson: column 2, lines 39 – 50); code segment (Ferguson: column 2, lines 39 – 50) for providing a medical service/good provider listing for the medical service/good providers based on the obtained information (Ferguson: column 14, lines 2 – 6), wherein the medical service/good provider listing is accessible by the members via a global telecommunications network (Ferguson: column 7, lines 37 – 42 and column 14, lines 2 – 6), is searchable by the members using one or more search criteria comprising a geographic area or a service/good provided by the medical service/good providers (Ferguson: column 10, lines 62 – 65); and

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a code segment (Ferguson: column 2, lines 39 – 50) for providing a discount price list to the members (Care Entrée: paragraph 41) via the global telecommunications network,(Ferguson: column 7, lines 37 – 42 and column 14, lines 2 – 6), wherein the discount price list comprises published rates for the services/goods provided by the medical service/good providers for two or more geographic areas (Ferguson: column 14, lines 21 – 31); and where each member can only access the published rates for the geographic area associated with the member (Ferguson: column 3, lines 41 - 55).

Ferguson fails to teach a computer program embodied on a computer readable medium executable by a server for providing a health care plan comprising: comprises basic listings and premium listings for the medical service/good providers and the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list.

Lipton teaches a computer program embodied on a computer readable medium executable by a server for providing a health care plan comprising: comprises basic listings and premium listings for the medical service/good providers (Lipton: paragraphs 7, 41 – 45, and 111) and the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider (Lipton: paragraph 30). Lipton fails to teach a health care plan comprising such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list.

Goch teaches a health care plan comprising such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list. (Goch: paragraph 20).

The motivation to combine the teachings of Care Entrée, Ferguson, Lipton, and Goch is discussed in the rejection of claim 26 and incorporated herein.

10. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ferguson et al., hereinafter Ferguson (U.S. Patent Number 5,819,092), in view of Care Entrée

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(<http://web.archive.org/web/200111130030647/http://carentree.com>, 2001) in view of Lipton, et al., hereinafter Lipton ("Pharmacy benefit management companies: Dimensions of performance", Annual Review of Public Health. Palo Alto: 1999. Vol. 20, page 361) further in view of Goch ("A New Card Deal." Best's Review. Oldwick: Jul 2002 (vol. 103, Iss. 3; page 73).

In regard to Claim 28 (currently amended): Ferguson teaches an apparatus for providing a health care plan comprising: a server (Ferguson: column 7, lines 42 – 47); one or more storage devices communicably coupled to the server (Ferguson: column 1, lines 44 - 49 and column 7, lines 41 - 49), the one or more data storage devices (Ferguson: column 1, lines 44 - 49) containing a discount price list to the members via a global telecommunications network (Ferguson: column 7, lines 37 – 42 and column 14, lines 2 – 6), wherein the discount price list comprises published rates for the services/goods provided by the medical service/good providers for two or more geographic areas (Ferguson: column 14, lines 21 – 31) and each member can only access the published rates for the geographic area associated with the member (Ferguson: column 3, lines 41 - 55), and a communications interface communicably coupled to the server (Ferguson: column 29, lines 2 – 14) is searchable by the members using one or more search criteria comprising the geographic area or a service/good provided by the medical service/good providers (Ferguson: column 10, lines 62 – 65).

Ferguson fails to teach an apparatus for providing a health care plan comprising: the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list, a communication device that allows the members to access the discount price list and the medical service/good provider listing, and a communication interface wherein the medical service/good provider listing comprises basic listings and premium listings for the medical service/good providers, and wherein the member is an individual that has paid a membership fee to join the health care plan.

Care Entrée teaches a health care plan comprising: a discount price list to the members (Care Entrée: paragraph 41); a communication device that allows the members to access the discount price list

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and the medical service/good provider listing (Care Entrée: paragraphs 11, 12, 13, 36, 38, 41, 61, 86, and 97), and wherein the member is an individual that has paid a membership fee to join the health care plan (Care Entrée: paragraph 10).

Care Entrée fails to teach an apparatus for providing a health care plan comprising: the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list, and a communication interface wherein the medical service/good provider listing comprises basic listings and premium listings for the medical service/good providers.

Lipton teaches an apparatus for providing a health care plan comprising: the discount price list regulates the cost of services/goods provided to the members by the medical service/good provider (Lipton: paragraph 30) and a communication interface wherein the medical service/good provider listing comprises basic listings and premium listings for the medical service/good providers (Lipton: paragraphs 7, 41 – 45, and 111). Lipton fails to teach an apparatus for providing a health care plan comprising: such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list.

Goch teaches an apparatus for providing a health care plan comprising: such that the members pay the medical service/good providers in-full directly for any services/goods rendered to the members based on the discount price list (Goch: paragraph 20).

The motivation to combine the teachings of Care Entrée, Ferguson, Lipton, and Goch is discussed in the rejection of claim 26 and incorporated herein.

Response to Amendment

11. Applicant's arguments filed October 29, 2008 have been fully considered but they are not persuasive. Applicant's arguments will be address herein below in the order in which they appear in the response filed.

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(1) In regard to claims 26 - 28, the applicants arguments are not persuasive as the limitations claimed are taught by the Care Entrée program, in view of Lipton and Goch, in further view of Ferguson. The applicant argues that combination of the Care Entrée and Lipton references do not disclose discount lists to individuals or members.

The Examiner disagrees in that the Care Entree program is a managed health care program which negotiates the cost of medical services or goods provided for individual members who have paid a member ship fee, as discussed in the rejection of claim 26, and provides a price list of services specific to a geographical region (Care Entrée: paragraphs 47 and 48).

Lipton, however, discloses a method in which PBM's represent groups (i.e. employers, HMO's).

The difference between the Care Entrée and the Lipton subject matter is that a PBM in the Care Entrée system collects fees and costs of medical procedures/pharmaceuticals from an individual, whereas Lipton collects from groups or organizations. The Goch reference is an article describing the Care Entrée system, and supports the Care Entrée reference by supplementing the information described in <http://web.archive.org/web/20011130030647/http://carentree.com>.

Since each element (collect of fees and costs of medical procedures/pharmaceuticals) and the function of the PBM are shown in the prior art, albeit shown as separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself – that is in the substitution of the collection of fees/costs from the group or organization of Lipton for the collection of fees/costs from individuals of Care Entree.

Thus, the simple substitution of one know element for another producing a predictable result renders the claim obvious.

(2) The applicant argues that it would not have been obvious to one of ordinary skill in the art at the time the invention was made to provide members with medical services or goods provided listing containing basic and premium listings of medical services/good providers. The Examiner disagrees, as stated in the rejections of claims 26, 27, and 28, in that Ferguson teaches an online system in which members can search a directory (column 4, lines 33 – 50), which the Examiner interprets as a basic listing. The directory can include hyperlinks (equating the directory to a premium listing) which would

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direct the member to a web page containing advertisements and/or information regarding a particular medical service or good provider (column 26, lines 8 – 24). For instance, a hyperlink may detail the insurance plans accepted by a provider.

(3) The Applicant argues that Care Entrée, Lipton and Goch do not disclose, teach or suggest providing the discount price list to the members via the global telecommunications network. In response to the Applicant's argument, it is respectfully submitted that the Examiner has applied new passages and new citations to the amended claims. The Examiner notes that the amended limitations were not in the previously pending claims; as such, Applicant's remarks with the regard to the application of Care Entrée, Lipton and Goch are addressed in the above Office Action.

(4) The Applicant argues that it would not be obvious to combine the non-Internet based systems of Care Entree, Lipton, and Goch with Ferguson's software development tool. The Examiner respectfully disagrees. The Care Entrée program is internet based (see <http://web.archive.org/web/20011130030647/http://carentree.com>, 2001) which would make it obvious to combine the teaching of Ferguson's online directory with the teaching of Care Entrée. Thus, the Applicant's argument is non-persuasive.

Claims 2 – 9 and 12 – 16 and 21 – 25 are dependent on claim 26, therefore, the same rationale for rejection is applied.

Conclusion

12. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action

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is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to KRISTINE K. RAPILLO whose telephone number is (571)270-3325. The examiner can normally be reached on Monday to Thursday 6:30 am to 4 pm Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Luke Gilligan can be reached on 571-272-67706770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

KKR

/C Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626